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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,991	12/02/2003	Michael M. Evans	2553.2.3	5217
28049	7590	11/03/2006	EXAMINER	
PATE PIERCE & BAIRD 215 SOUTH STATE STREET, SUITE 550 PARKSIDE TOWER SALT LAKE CITY, UT 84111			DANIELS, MATTHEW J	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/725,991

Applicant(s)

EVANS ET AL.

Examiner

Matthew J. Daniels

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/2/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Oath/Declaration*

1. The correction of inventorship under 37 CFR 1.48 is noted.

### *Claim Objections*

2. **Claim 1** is objected to because of the following informalities: “scheme” appears to be unnecessary because if there is a color, there is inherently a scheme. Appropriate correction is required. Claim 1 is also objected to because the “exposed portion and a covered portion” are drawn to the intended method of use of the object, and are not process steps in the method of making. There is no step of exposing or covering claimed.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1 and 22** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over De Paoli (USPN 2835996). **As to Claim 1**, De Paoli teaches a method for decorating a cementitious substrate (1:61), the method comprising:

selecting a base color scheme for a substrate formed of a cementitious material (1:59-65);

selecting an accent color scheme (2:1-15);

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providing the substrate having the base color scheme and a top surface (1:59-65);  
applying before curing, to the exposed portion of the surface of the substrate, a substantially random distribution of medallions of a cementitious material as accents, colored in the accent color scheme (2:1-15);  
curing together the substrate of the accent medallions to form a durable, bonded, color-accented substrate (2:13-19).

De Paoli is silent to the top surface having an exposed portion and a covered portion. However, De Paoli teaches an article having a top surface with a portion capable of being exposed and a portion capable of being covered. This limitation appears to be drawn to the intended use, which would be fulfilled by De Paoli's article, which could obviously be used in the same way.

**As to Claim 22**, De Paoli clearly teaches that the medallions are formulated of a cementitious material which contains cement, water, and aggregate (2:1-15). De Paoli teaches cement and aggregate (2:4-5), but does not explicitly teach the water, however, it would have been inherent or obvious that it also contains water in that the spatters are "semi-plastic" (2:8), which would not occur without water addition.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 2, 5-21, 23-29, and 31-52, 54-60** are rejected under 35 U.S.C. 103(a) as being unpatentable over De Paoli (USPN 2835996). **As to Claim 2**, De Paoli clearly teaches a process of using a strike off board or straight edge in a sawing motion (2:60-61), which would obviously texture the top surface and would obviously provide a substantially random pattern. **As to Claims 5-21, and 54-60**, De Paoli clearly provides teaching and suggestion that “The colors of the base terrazzo and the colors of the terrazzo spatter inserts can be varied to produce unusual artistic effects.” (2:28-30) Additionally, De Paoli teaches “cement...which is of uniform or complementary color with the terrazzo colors.” (3:15-18). Clearly De Paoli suggests a wide range of colors and effects, which would obviously be of different colors, inherently corresponding to or matching natural tones, hues, minerals, ages, biota, metal oxides, deposits, and plants, and reads on the claimed invention.

**As to Claims 23-29, 31-33**, De Paoli teaches a proportion of about 20% Portland cement to aggregate (2:48-58), that the particular consistency should be changed by adjusting the proportions of aggregate and cement (2:59-63), sand that could be used as masonry sand (2:51), and varying degrees of pigment (3:11-20 and 2:26-35) and water (2:48-59). De Paoli therefore teaches that color, cement/aggregate ratio, and water represent result effective variables which should be optimized in order to produce unusual artistic effects and provide the most optimum and driest possibly consistency.

**As to Claims 34-40**, De Paoli clearly suggests that the medallions should be “inserted in selected areas of the semi-plastic slab to form a suitable design.” (2:1-2). Also see De Paoli’s teaching of “semi-plastic or partially cured state” (2:68-69). De Paoli clearly teaches that the ordinary artisan should choose or select a time at which the mixture is still plastic, which would

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have suggested to the ordinary artisan (a) any time over 1 second, and (b) that time at placement also represents a result effective variable that should be optimized to maintain the semi-plastic layer. Doing so would obviously provide integrated cohesion, as claimed.

**As to Claims 41-43**, the medallions of De Paoli are formed of a cement material which would have a liquid content and depth which would obviously or inherently simulate the appearance of biota.

**As to Claims 44-47 and 52**, De Paoli clearly suggests texturing the material by working with a sawing motion and a strike-off board or straight-edge (2:60-61), which would inherently or obviously produce random linear patterns, longitudinal patterns, and obtuse angles. The teachings of De Paoli are interpreted to be a manual brushing step, and moreover, the Examiner takes official notice that the texturing steps of Claims 44-47 and 52 are conventional in the art.

**As to Claims 48-51**, the claimed subject matter appears to be a limitation drawn to requirement of the occupation of the individual choosing the color scheme. The Examiner asserts that De Paoli performing his disclosed process is both a producer, designer, architect, and user.

5. **Claims 3, 4, and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over De Paoli (USPN 2835996) in view of Arpin (USPN 2918385). De Paoli teaches the subject matter of Claims 1 and 22 above under 35 USC 102(b) or alternatively under 35 USC 103(a). **As to Claims 3, 4, and 30**, De Paoli clearly teaches that the “driest consistency possible” (2:59-60) should be used, but is silent to low or zero slump concrete. However, Arpin teaches low to zero slump concrete (2:15-20), which would be the driest consistency possible as it would not provide

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excess water to cause slumping. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Arpin into that of De Paoli in order to provide the driest consistency possible, as suggested by De Paoli, and to provide a quick setting material.

6. **Claim 53** is rejected under 35 U.S.C. 103(a) as being unpatentable over De Paoli (USPN 2835996) in view of Maletic (USPN 4940358). De Paoli teaches the subject matter of Claim 44 above under 35 USC 103(a). **As to Claim 53**, De Paoli appears to be silent to a texturing process which comprises automatically and mechanically brushing the substrate by a mechanical device. However, Maletic teaches a texturing process which comprises automatically and mechanically brushing the substrate by a mechanical device (Figs. 1-8). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Maletic into that of De Paoli in order to provide a textured surface which would avoid slipping and which efficiently performs the texturing task.

7. **Claims 12, 15-20 and 54-60** are rejected under 35 U.S.C. 103(a) as being unpatentable over De Paoli (USPN 2835996) in view of Gundlach (USPN 2057679) and Chaffee (USPN 1993086). De Paoli teaches the subject matter of Claim 1 above under 35 USC 102(b), or alternatively, under 35 USC 103(a). **As to Claims 12, 15-20 and 54-60**, De Paoli clearly provides teaching and suggestion that "The colors of the base terrazzo and the colors of the terrazzo spatter inserts can be varied to produce unusual artistic effects." (2:28-30) Additionally, De Paoli teaches "cement...which is of uniform or complementary color with the terrazzo

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colors.” (3:15-18). Clearly De Paoli suggests a wide range of colors and effects, which would obviously be of different colors, inherently corresponding to or matching natural tones, hues, minerals, ages, biota, metal oxides, deposits, and plants, and reads on the claimed invention.

Although De Paoli is believed to suggest all color variations, De Paoli does not explicitly teach that the colors simulate biota. “Biota” may be interpreted to be any of the colors that simulate those of biota found in nature (the interpretation set forth in the rejection of Claims 12, 15-20 and 54-60 under 35 USC 103(a) over De Paoli). Alternatively, “biota” may be interpreted to be a green color. In this alternative interpretation, De Paoli is silent to the biota colors.

However, Gundlach teaches that green pigment may be mixed with aggregates and cement to form objects that are suitable as medallions (page 1, left column, line 54 - page 1, right column, line 39) and Chaffee teaches that it is conventional to provide cementitious roofing tiles with a green coloring (page 2, left column, line 25 – page 2, right column, line 51). It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the methods of Gundlach and Chaffee into that of De Paoli in order to provide cement having a highly weather resistant, aesthetically pleasing, and natural looking coloring to the articles of De Paoli. Also note that Chaffee additionally suggests at least one texture (page 2, left column, lines 56-68).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJD 10/23/06



  
CHRISTINA JOHNSON  
SUPERVISORY PATENT EXAMINER

10/27/06